

RESPONSE

Claims 1 - 25 remain in this application. The Examiner has required a restriction and the Applicants have elected to prosecute Claims 7 - 25. Accordingly, Claim 1 has been withdrawn and Claims 2 - 6 have been cancelled. Claims 7 - 25 have been rejected. The Applicants submit the following remarks and hereby requests a timely notice of allowance.

The Specification has been amended (beginning on pages 7, first paragraph to end of said paragraph) to delete "system for analyzing resource allocation" and insert an article for performing the method of monitoring a surfactant. A replacement paragraph showing the changes to the specification is provided hereinabove.

Claim Rejections under 35 USC 112, Second Paragraph:

Claims 7, 11 - 15, 24 and 25 have been rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner takes the position that Claim 7 is unclear as to where exactly the surfactant is deposited. Claim 7 has been amended to make it more clear that the image and the surfactant are deposited onto the same surface of the substrate. The Applicant submits that the Claims when read in light of the subject specification are clear and particularly point out and distinctly claim the subject invention. The Examiner also has taken the position that Claims 10 - 18 have process limitations whereas Claim 7 is drawn to an article. The Applicants submit that the language used in Claims 10 - 18 have been used by the attorney

of record and accepted without objection by the USPTO for over twenty years. However, the Applicants have amended the Claims in order to overcome the Examiner's concerns. With respect to Claims 24 and 25, Claim 24 makes it clear that the "image is covered by a coating effective for controlling the disappearance time of the image." The Applicants submit that this sufficiently makes clear the claimed limitation. The Applicants respectfully submit that the Examiner is attempting to require the Applicants to further limit the Claim. This is not appropriate. The limitation is that the image is covered by a coating.

In view of the foregoing, the Applicants respectfully submit that the rejection of Claims 7, 11 - 15, 24 and 25 under 35 U.S.C. 112, second paragraph, should now be withdrawn.

The rejection of Claims 7 - 9, 11 - 21 and 23 as being rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication of Godbey et al. (2002/0187181) is respectfully traversed.

The Examiner takes the position that Godbey et al. teaches an article for applying and monitoring a surfactant/surface active agent that comprises a substrate (carrier), an image positioned on the surface of the substrate (part of the one or more surface active agents in the layer/portion), and a surfactant deposited on the substrate (the one or more active agents). Further, the Examiner takes the position that Godbey et al. teaches that the surfactant is an epidermal surfactant. Further, the Examiner believes that Godbey et al. teaches that the surfactant can consist of any of the surfactants taught in the instant application.

The Applicants respectfully submit that the Examiner's belief that one or more of the surfactant active agents is an "image" such as the image of the subject application is unfounded. The "image" as described in the subject application is applied to the surface of the substrate and is effective for indicating the quantity or effectiveness of the surfactant. In contrast, the Examiner takes the position that Godbey et al. teaches a substrate (the carrier) and an image positioned on the surface of the substrate (citing the Abstract, paragraphs [0001], [0004], [0005], [0007], [0008], [0019] and [0020] Claim 1 of Godbey et al.). The Applicant submits that a review of the Examiner's citations does not show an image or even a teaching or a suggestion of the desirability of an image effective for indicating the quantity or effectiveness of the surfactant. The device disclosed in Godbey et al. may have a "decorative utility, for example, as temporary tattoos, masks or decorative appliques on the skin, toenails, fingernails or teeth, or by delivering hair color or skin color" (see [0021]) or a delivery means such as for forming a mask (see [0033], or for providing treatment to fingernails or toenails (see [0050]). This "image" is structurally and functionally significantly different than an image effective for indicating the quantity or effectiveness of the surfactant.

The Examiner states that "if one of the active agents is to be an image, and the other agent is a different type of agent/surfactant, it follows that as the surfactant either wears off of or is absorbed into, the skin of the user, then the image that is presented could very easily fade or become more visible, depending on the nature of the surfactant that is covering the image portion of

the article.” The Examiner however, shows no such image or even a suggestion or teaching of the desirability of such an image in the cited reference and has not satisfied the requirements for saying that the claim limitations are inherent in the cited reference. Indeed, the only disclosure of such an image or a teaching or suggestion of the desirability of such an image comes from the subject specification. Indeed, the only image disclosed in the cited reference are for decorative utility such as tattoos, masks or appliques on the skin, toenails, fingernails or teeth, or by delivering hair color or skin color.” The Applicants find no images effective for indicating the quantity or effectiveness of the surfactant. With respect to the claims rejected as anticipated under 35 USC 102, the MPEP provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The alleged prior art invention “must be shown in as complete detail as contained in the... claim.” MPEP 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). As shown above, the Examiner has not demonstrated that each element of the rejected claims is contained in the cited prior art. Nor, has the Examiner shown that such an image is inherent in the reference invention.

Claims 8 -9, 11 - 21 and 24 that depend from amended Claim 7 are believed to be allowable for the reasons stated above.

In view of the foregoing, the Applicants respectfully submit that Claims 7 -

9, 11 - 21 and 24 are allowable and the rejection under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent Application Publication of Godbey et al. (2002/0187181) should be withdrawn.

The rejection of Claims 10 and 22 under 35 U.S.C. 103(a) as being unpatentable over Godbey et al. and further in view of either Applicant's admissions or U.S. Patent Application Publication of Dole et al. (2003/0044366) is respectfully traversed.

The Examiner takes the position that Godbey et al. teaches that an image can comprise colorants, dyes and printing and that the Applicant admits that the inks described in the subject application are well-known in the art. The Examiner also takes the position that Dole et al. is drawn to a composition that changes color and teaches that the colorant can cause a color change as a surfactant dissipates. The Examiner believes that since Godbey et al. , Dole et al. and the instant application are all drawn to related fields of the invention, they all address the specific use of the same surfactants on the skin of the user, it would have been obvious to a person having ordinary skill in the art to use the inks, especially in a color-changing composition, that are claimed in the instant application.

In establishing a prima facie case of obviousness, three criteria must be met:

- i. Some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and
- ii. A reasonable expectation of success; and

- iii. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2143. The Examiner has not established a prima facie case of obviousness with respect to applicant's Claims 10 and 22.

The Applicant submits that as shown above Godbey et al. does not teach, suggest, or disclose an image effective for indicating the quantity or effectiveness of the surfactant and there is no showing that one skilled in the art would be motivated to combine the teachings of the Godbey et. al. and Dole et al. to arrive at the claimed invention. The Examiner has only presented an argument that if one combines the references and selects the proper surfactants, provides an image, and constructs the apparatus properly, one could create the claimed invention. However, the Examiner fails to show the motivation to combine the cited references and to select and structure the apparatus in such a way as to create the claimed invention. Even if all of the elements of the claim are disclosed in the cited references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art as to why one of ordinary skill would have been prompted to combine the teachings of the references in such a way as to arrive at the claimed invention.

Claim 10 depends on Claim 7 which requires an image that effective for indicating the quantity or effectiveness of the surfactant. The only such teaching of such an image comes from the Applicant's own specification. Therefore, the combination of references does not teach or suggest all the claim limitations of applicant's Claim 10.

The cited references do not contain any suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to combine and modify the reference **and the Examiner has not provided any showing of such motivation or teaching**. The Examiner simply states that “Godbey teaches that a single article can comprise one active agent or that the article can also comprise multiple active agents. Therefore, if one of the active agents is to be an image, and the other agent is a different type of agent/surfactant, it follows that as the surfactant either wears off or is absorbed into, the skin of the user, then the image that is present could very easily fade or become more visible, depending on the nature if the surfactant that is covering the image portion of the article.” Again, the only image disclosed in Godbey et al. comprises an image to be applied, such as to the skin of a person. **There is no teaching that an “image” would be or should be covered by a surfactant or applied such that it fades when a surfactant is used, or becomes more visible when a surfactant is used.** The “image” taught in Godbey et al. is structurally and functional different than the “image” taught in the subject application. Further, Dole et al. teaches a skin care composition such as a facial mask comprising paste, lotion, gel or cream that changes color to indicate that the composition has dried sufficiently. Thus, the color change taught by Dole et al. is operates in a manner completely different than the claimed invention and does not operate to indicate the quantity or effectiveness of the surfactant and is therefore structurally and functionally different than the claimed article.

Because neither reference contains any teaching, motivation or

suggestion for creating an article having an image effective for indicating the quantity or effectiveness of the surfactant there could be no reasonable expectation of success in combining the references to read all the limitations of Claims 10 and 22. Therefore, this element of the prima facie case of obviousness has not been established with respect to Applicants' Claims 10 and 22.

In view of the foregoing, the rejection of Claims 10 and 22 under 35 U.S.C. 103(a) as being unpatentable over Godbey et al. and further in view of either Applicant's admissions or U.S. Patent Application Publication of Dole et al. (2003/0044366) should be withdrawn.

In view of the foregoing Amendment and Remarks, Applicants respectfully request reconsideration of the Application and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



February 8, 2008

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